

REMARKS

Claims 1-101 are pending. Claims 5-101 are withdrawn from consideration.

Elections/Restrictions

Applicants thank the Office for acknowledging the election of the subject matter of Group II, the compounds and compositions according to claim 1 of formula I, wherein X is C, with traverse. Applicants note for the Examiner's convenience that, for each of the compounds claimed herein, X is C. Applicants respectfully request that those additional claims, currently withdrawn, be rejoined with the elected group.

Rejections under 35 U.S.C. §112

Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, because allegedly the specification, while being enabling for other forms, does not reasonably provide enablement for solvates. The Examiner further states that the specification allegedly does not enable a person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Solely to advance prosecution Applicants have amended the claims to delete the term "solvates". Since solvates are a form species of the presently claimed compounds and salts, the present claims nonetheless encompass such forms. Applicants request that the rejection be withdrawn.

Rejections under 35 U.S.C. §102

Claims 1-4 are rejected under 35 U.S.C. 102(b), as allegedly being anticipated by Sablayrolles et al. (WO 88/04298). Applicants traverse this rejection.

Sablayrolles is cited for teaching imidazopyrazin-8-yl amines. However, none of the compounds described in the reference fall within the scope of the pending claims. Specifically, none of the compounds in Table III (or elsewhere in the reference) have a phenylene group (or a pyridinyl group) attached to the imidazopyrazine core. Sablayrolles thus does not anticipate the claimed invention. Applicants respectfully request that the rejection be withdrawn.

Rejections under 35 U.S.C. §103

Claims 1-10, 12, and 17 are rejected under 35 U.S.C. 103(a), as allegedly being unpatentable over Sablayrolles et al. (WO 88/04298). Applicants note that, in a telephone conference with Examiner Ward on December 13, 2006, the Examiner indicated that claims 1-4 were rejected and not claims 1-10, 12 and 17 as indicated in the Office Action. Applicants respectfully traverse this rejection.

As noted by the Office, Sablayrolles describes a generic group of imidazopyrazin-8-ylamine derivatives. However, “[t]he claims differ from the reference by reciting specific species and a more limited genus than the reference.” The Office argues that it would have been obvious to one of skill in the art to select any of the species of the genus taught by the reference and then somehow combine them to produce the claimed invention “because any of the species of the genus would have similar properties”. However, picking and choosing is not the test for obviousness.

Rather, A *prima facie* case of obviousness requires the Office to cite to a ***reference or combination of references that (a) discloses all the elements of the claimed invention, (b) suggests or motivates one of skill in the art to combine or modify those elements to yield the claimed combination, and (c) provides a reasonable expectation of success should the claimed combination be carried out*** (*See, e.g., Northern Telecom Inc. v. Datapoint Corp.*, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990); and *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988)). Failure to establish **any one** of these three requirements precludes a finding of a *prima facie* case and, without more, entitles applicant to allowance of the claims at issue. As stated in *In re Dow Chemical Co.*, 5 USPQ2d 1529 (Fed. Cir. 1988):

The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art.... Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure.

As discussed above, the cited art does not describe any species falling within the scope of the pending claims. Moreover, the cited art does not describe any compounds, either generically or specifically, having a phenylene group attached to the imidazopyrazine core. Group Y of Sablayrolles cannot be substituted phenyl as required by the pending claims.

Thus, the cited art does not teach each and every element of the present invention. As such, the Office Action fails to make a proper *prima facie* case of obviousness. Applicants respectfully request that this rejection be withdrawn.

CONCLUSION


In view of the foregoing amendments and remarks, Applicants respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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